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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/994,222 | 11/26/2001 | Joshua Makower | TRNSV-013BCC | 1596 |

7590

03/18/2005

MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
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SANTA ROSA, CA 95403

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| EXAMINER |
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ISABELLA, DAVID J

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| ART UNIT | PAPER NUMBER |
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3738

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 09/994,222 | Applicant(s) MAKOWER ET AL. | |
| | Examiner DAVID J ISABELLA | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 1-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of the Claims

Claims 65-70 are pending for immediate action. Claims 1-64 are withdrawn from further consideration as being drawn to a non-elected invention. Claims 71-82 have been cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 65,67,69 and 70 are rejected under 35 U.S.C. 102(b) as being anticipated by Lois (5851232).

Lois discloses a stent apparatus comprising; a tubular body which has a length and alternately configureable in a radially collapsed configuration of a first diameter; and ii) a radially expanded configuration of a second diameter, said second diameter being at least as large as the diameter of the in vivo passageway; and a covering formed on at least a part of said tubular body to direct blood flow through the tubular body in a desired direction.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b); by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 65-70 are rejected under 35 U.S.C. 102(e) as being anticipated by any of Giocoechea (6010530), Knudson (6361519) and Pinchasik et al (5980552).

Each of Giocoechea (6010530), Knudson (6361519) and Pinchasik et al (5980552) discloses a stent apparatus comprising; a tubular body which has a length and alternately configureable in a radially collapsed configuration of a first diameter; and ii) a radially expanded configuration of a second diameter, said second diameter being at least as large as the diameter of the in vivo passageway; and a covering formed on at least a part of said tubular body to direct blood flow through the tubular body in a desired direction.

The claims are directed to an apparatus, more particularly, a protrusive stent. The intended use of the stent (ie for stenting a myocardial passageway) does not necessarily impart further structural limitation to the same. The structural limitations of the claims as interpreted by the examiner are a tubular body which has a length and alternately configureable in a radially collapsed configuration of a first diameter; and ii) a radially expanded configuration of a second diameter, said second diameter being at least as large as the diameter of the in vivo passageway; and a covering formed on at least a part of said tubular body to direct blood flow through the tubular body in a desired direction. Examiner contends that each stent as relied upon, disclose the structure as claimed and therefor, each stent is capable of being used in the manner as set forth by applicant's method.

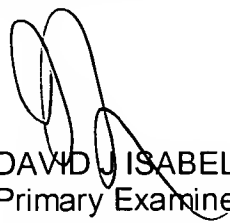
Claim 66, see prosthesis of Giocoechea.

Claim 68, see any of Giocoechea, Knudson and Pinchasik et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-THURSDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J ISABELLA
Primary Examiner
Art Unit 3738

DJI
March 14, 2005